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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

ATTORNEY DOCKET NO.: AUS000060US1

In re Application of:

RABINDRANATH DUTTA	§	
	§	
	§	Examiner: **RUDY, ANDREW J.**
Serial No.: **09/535,559**	§	
	§	
Filed: **March 27, 2000**	§	Art Unit: **3627**
	§	
For: **THIRD PARTY CONTRACT**	§	
DEPOSITORY FOR E-COMMERCE	§	
TRANSACTIONS	§	

APPEAL BRIEF UNDER 37 C.F.R. §1.192

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Sir:

This Brief is submitted in support of the Appeal of the Examiner's final rejection of Claims 5, 7, 11-14 and 19-20 in the above-identified application. A Notice of Appeal was filed in this case on December 21, 2004 and received in the United States Patent and Trademark Office on December 21, 2004. Please charge the fee of $500.00 due under 37 C.F.R. §1.17(c) for filing the brief, as well as any additional required fees, to **IBM Deposit Account No. 09-0447.**

REAL PARTY IN INTEREST

The real party in interest in the present Application is International Business Machines Corporation, the Assignee of the present application as evidenced by the Assignment set forth at reel 010712, frame 0812.

RELATED APPEALS AND INTERFERENCES

An appeal filed in related patent application Serial Number 09/534,595 (Atty. Doc. AUS000060US2) filed on December 15, 2003 may directly affect or be directly affected by the Board's decision in the present appeal. There are no other appeals or interferences known to Appellant, the Appellant's legal representative, or assignee, which directly affect or would be directly affected by or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Following a non-final action dated April 15, 2004, Appellant filed an Amendment to the claims, which amendment included new claims 21-27. In the Final Action dated October 8, 2004, Examiner restricted new claims 21-27 from consideration as being directed to a non-elected invention. The remaining claims, i.e., Claims 5, 7, 11-14 and 19-20, were finally rejected, and the rejection of Claims 5, 7, 11-14 and 19-20 is being appealed.

STATUS OF AMENDMENTS

No amendments to the remaining claims have been made subsequent to the final rejection that leads to this Appeal.

SUMMARY OF THE CLAIMED SUBJECT MATTER

Appellant's claimed invention provides a database/depository that stores documents generated by an E-commerce transaction. The database is independent of the server and client system that complete the transaction, and the database generates a document ID for each document that is stored therein. This database-generated document ID (i.e., one generated at the database during storage therein and not one generated at the server during the transaction) is described in the claims as a separate/different ID from the transaction ID generated by the server

during the transaction. Providing a separate database-generated ID along with the transaction ID allows for independent storage of the created document.

Appellant's claims recite several novel features including the following:

means for automatically receiving an electronic document dynamically generated ... at an E-commerce server ... independent of the electronic database, whereby said electronic document stored at said electronic database cannot be modified by either party to the E-commerce transaction;

means for generating a document identifier (ID) ... at said database; ... and

means for transmitting said document ID to each party to said E-commerce transaction

(emphasis added).

Notably, exemplary Claim 11 specifically recites:

wherein said document ID is generated at said depository and is separate from a transaction ID assigned to the E-commerce transaction.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A.   The Examiner's rejection of Claims 5, 7, 11-14, 19 and 20 under 35 U.S.C. §103(a) as being unpatentable over *Quelene* (U.S. Patent No. 6,453,306) is to be reviewed on Appeal.

ARGUMENT

A.   Examiner's rejection of Claims 5, 7, 11-14, 19 and 20 under 35 U.S.C. §103(a) as being unpatentable over *Quelene* is not well founded and should be reversed.

Independently Generating and Transmitting a Document ID Different From The Transaction ID (Claims 5, 7, 11-14, 19 and 20).

The specific language of Appellants claimed invention is recited above.   A careful reading of *Quelene* reveals that *Quelene* is devoid of any teaching or suggestion of any one of

the above highlighted features of Appellant's claims and their associated element. Specifically, *Quelene* fails to teach or suggest any one of:

> *(1) means for generating a document identifier (ID) ... at said database; ...*
>
> *(2) means for transmitting said document ID to each party to said E-commerce transaction; or*
>
> *(3) wherein said document ID is generated at said depository and is separate from a transaction ID assigned to the E-commerce transaction*

Examiner glosses over the specific features recited in Appellant's claims by stating generally that *Quelene* discloses "an electronic database where an electronic document has an associated identifier and is stored." Examiner also states that "it is common knowledge ... to provide non-modifiable read access electronic databases having a document identifier stored at a electronic database."
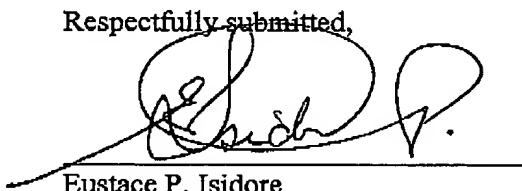
Examiner fails to tie in the teachings of *Quelene* with any of the functional features provided by Appellants claimed invention. It is clear that *Quelene* does not teach or suggest generating the document ID at the database or that the document ID generated is different from the transaction ID of the e-commerce transaction that created the document. Notably, during a telephonic conference with Appellant's representative, Examiner informally agreed that providing two different IDs (a database-generated document ID and a transaction ID) was not provided by either *Quelene* or "Ebay" (referenced without support within the final rejection).

Thus, *Quelene* does not render Appellant's claimed invention obvious to one skilled in the art because *Quelene* is devoid of any teaching or suggestion of the above listed or other features recited by Appellant's claims. Examiner's rejection is therefore not well founded and should be reversed.

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CONCLUSION

Appellant has pointed out with specificity the manifest error in the Examiner's rejections, and the claim language that renders the invention patentable over the reference.   Appellant, therefore, respectfully requests that this case be remanded to the Examiner with instructions to issue a Notice of Allowance for all pending claims.

Respectfully submitted,

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APPENDIX

1-4.   (canceled)

5.   An electronic database used as a depository for electronic documents generated during E-commerce transactions, comprising:

means for automatically receiving an electronic document dynamically generated from information provided during an E-commerce transaction that has completed at an E-commerce server, which server is independent of the electronic database, whereby said electronic document stored at said electronic database cannot be modified by either party to the E-commerce transaction;

means for generating a document identifier (ID) for said received E-commerce generated electronic document, wherein said document ID is generated at said database;

means for storing said E-commerce generated electronic document with said document ID; and

means for transmitting said document ID to each party to said E-commerce transaction that produced said electronic document.

6.   (canceled)

7.   The electronic database of Claim 5, wherein said means for storing further comprises:

means for allowing a later read access to said E-commerce generated electronic document by a party to said E-commerce transaction; and

means for preventing modifications to said E-commerce generated electronic document after said document has been stored.

8-10.   (canceled)

11.   A depository for ensuring authenticity of electronic documents generated during E-commerce transactions, said depository comprising:

means for enabling automatic receipt of an electronic document that is dynamically generated in response to a completion of an E-commerce transaction in which information

utilized to generate said electronic document is provided, wherein said E-commerce transaction is completed at a server that is independent of said depository;

means for generating a document identifier (ID) to identify said E-commerce generated electronic document being stored at the depository, wherein said document ID is generated at said depository and is separate from a transaction ID assigned to the E-commerce transaction; and

means for storing said E-commerce generated electronic document in said depository along with said document ID that is utilized to reference and retrieve said electronic document from said depository.

12.   The depository of Claim 11, wherein said storing means includes:

means for limiting a write access of said electronic document to a first access; and

means for restricting subsequent access to said electronic document to read-only access, such that no changes may be made to said electronic document once it has been stored.

13.   The depository of Claim 11, further including:

means for controlling a read and write access to said electronic depository, wherein said electronic document is stored in a write-once, read-many format;

means for providing said document ID to each party of the E-commerce transaction; and

means for later retrieving said electronic document for read access by a party to said E-commerce transaction utilizing said document ID.

14.   The depository of Claim 13 wherein said controlling means further includes:

means for enabling a non-modification function for said electronic document, wherein a control code of said electronic depository is activated to prevent later modification to said electronic document; and

when said depository also stores other documents that are not generated by the E-commerce transactions, means for flagging each E-commerce generated electronic document stored within said electronic depository to allow only a later read access to said E-commerce generated electronic document by a party to said E-commerce transaction, wherein write access is permitted for said other documents that are not flagged.

15-18. (canceled)

19.   The electronic database of Claim 5, further comprising:

means for connecting said electronic database to a separate, independent server at which said E-commerce transactions are conducted; and

means for enabling communication between said server and said electronic database via said connecting means.

20.   The depository of Claim 11, further comprising:

means for connecting said depository to a separate, independent server at which said E-commerce transactions are conducted; and

means for enabling communication between said server and said depository via said connecting means.

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